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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,715	06/26/2001	Richard L. Mueller	5756-0013.30	1828

20583 7590 12/10/2007

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EXAMINER	
STIGELL, THEODORE J	
ART UNIT	**PAPER NUMBER**
3763	

MAIL DATE	DELIVERY MODE
12/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/891,715	MUELLER ET AL.	
	Examiner	Art Unit	
	Theodore J. Stigell	3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *35-46,49,51 and 52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *35-46,49,51 and 52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/27/2007 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 35-45, 49, and 51-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al. (6,416,490). See Figures 3 and 5 and the respective portions of the specification. Ellis discloses a device (20) for treating tissue comprising an elongate shaft having a proximal end, a distal end, and a lumen extending between the proximal end and the distal end, at least one injury effector (23) located at the distal end

of the elongate shaft, capable of producing an injury at a first tissue location, and having no therapeutic substance delivery capabilities, at least one therapeutic substance delivery effector (30,36) located at the distal end of the elongate shaft, capable of delivering a therapeutic substance to a second tissue location, and at least one marking effector (30 can deliver therapeutics or marking agents, see column 4, lines 15-17) located at the distal end of the elongate shaft for creating a position marker at a third tissue location to indicate treated tissue; wherein the at least one injury effector and the at least one marking effector are capable of being sequentially actuated by a control structure, wherein at least a portion of the lumen is configured to receive the therapeutic substance; and wherein at least a portion of the at least one injury effector passes through, and is electrically isolated from (by insulators 24 and 26), the portion of the lumen configured to receive the therapeutic substance, and wherein the marking effector and the injury effector are separate from each other.

Claims 35-46, 49, and 51-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Negus et al. (6,902,562). Negus discloses a device (12) for treating tissue comprising an elongate shaft having a proximal end, a distal end, and a lumen extending between the proximal end and the distal end, at least one injury effector (14) located at the distal end of the elongate shaft, capable of producing an injury at a first tissue location, and having no therapeutic substance delivery capabilities, at least one therapeutic substance delivery effector (208) located at the distal end of the elongate shaft, capable of delivering a therapeutic substance to a second tissue location, and at least one marking effector (16) located at the distal end of the elongate shaft for

creating a position marker at a third tissue location to indicate treated tissue; wherein the at least one injury effector and the at least one marking effector are capable of being sequentially actuated by a control structure, wherein at least a portion of the lumen is configured to receive the therapeutic substance; and wherein at least a portion of the at least one injury effector passes through, and is electrically isolated from the portion of the lumen configured to receive the therapeutic substance, and wherein the marking effector and the injury effector are separate from each other.

Response to Arguments

Applicant's arguments with respect to claims 35-46, 49, and 51-52 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore J. Stigell whose telephone number is 571-272-8759. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Theodore J. Stigell

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